

- 1401 Reissue
- 1402 Grounds for Filing
- 1403 Diligence in Filing
- 1404 Submission of Papers Where Reissue Patent is in Litigation
- 1410 Content of Reissue Application
- ♦1410.01 Reissue Applicant, Oath or Declaration, and Assent of All Assignees♦
- 1411 Form of Specification
- 1411.01 Certificate of Correction in Original Patent
- 1411.02 New Matter
- 1412 Content of Claims
- 1412.01 Reissue Claims Must Be for Same General Invention
- 1412.02 Recapture of Cancelled Subject Matter
- 1412.03 Broadening Reissue Claims
- 1413 Drawings
- 1414 Content of Reissue Oath or Declaration
- 1414.01 Reissue Oath or Declaration under § 1.175(a)(1), (a)(2), and (a)(3)
- 1414.02 Reissue Oath or Declaration under § 1.175(a)(4)
- 1414.02(a) Information Considered under § 1.175(a)(4)
- 1414.03 Requirements of § 1.175(a)(5)
- 1414.04 Requirements of § 1.175(a)(6)
- 1414.05 Requirements of § 1.175(a)(7)
- 1415 Reissue Filing and Issue Fees
- 1416 Offer to Surrender and Return Original Patent
- ♦1417 Claim for Benefit under 35 U.S.C. 119
- ♦1418 Information Disclosure Statement and Other Information
- ♦ ♦ ♦
- 1430 Reissue Files Open to the Public ♦and Notice of Filing Reissue Announced in Official Gazette♦
- ♦1431 Notice in Patent File
- 1440 Examination of Reissue Application
- 1441 Two-Month Delay Period
- 1442 Special Status
- 1442.01 Litigation Related Reissues
- 1442.02 Litigation Not Stayed
- ♦1442.03 Litigation Stayed
- ♦1442.04 Litigation Involving Patent
- 1442.05 Cases in Which Stays Were Considered
- 1442.05(a) Stays Granted
- 1442.05(b) Stays Denied
- 1443 Initial Examiner Review
- 1444 Review of Reissue Oath or Declaration
- 1444.01 Conversion from § 1.175(a)(4) to (a)(1) Requires New Oath or Declaration
- 1445 Reissue Application Examined in Same Manner as Original Application
- 1446 Rejection Made Where No Changes in Patent and Claims Remain Patentable
- 1447 Additional Information, Affidavits, or Declarations Required
- 1448 Deferral of Fraud ♦, Inequitable Conduct♦ or Duty of Disclosure Issues
- 1449 Protest Filed in Reissue Where Patent is in Interference
- 1449.01 Concurrent Office Proceedings
- 1450 Restriction and Election of Species
- 1451 Divisional Reissue Applications
- ♦1453 Amendments to Reissue Applications♦
- 1455 Allowance and Issue
- 1456 Reissue Review
- 1460 Effect of Reissue
- 1480 Certificate of Correction—Office Mistake
- 1481 Applicant's Mistake
- 1485 Handling of Request for Certificate of Correction
- 1490 Disclaimers

Errors in a patent may be corrected in four ways, namely (1) by reissue, (2) by the issuance of a certificate of correction which becomes a part of the patent, (3) by disclaimer, and (4) by reexamination.

1401 Reissue

35 U.S.C. 251. *Reissue of defective patents.* Whenever any patent is, through error without any deceptive intention, deemed wholly

or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

1402 Grounds for Filing [R-3]

The most common bases for filing a reissue application are (1) the claims are too narrow or too broad; (2) the disclosure contains inaccuracies; (3) * * * applicant failed to or incorrectly claimed foreign priority; (♦4♦) applicant failed to make reference to or incorrectly made reference to prior copending applications.

♦An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in *In re Wilder*, 222 USPQ 369 (Fed. Cir. 1984). The Patent and Trademark Board of Appeals held in *Ex parte Scudder*, 169 USPQ 814, 815 (1971) that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate. Reissue may no longer be necessary under the facts in *Ex parte Scudder* in view of 35 U.S.C. 116 as amended effective November 8, 1984 by Public Law 98-622 which provides, *inter alia*,

"Inventors may apply for a patent jointly even though . . . (3) each did not make a contribution to the subject matter of every claim in the patent."

Note 37 CFR 1.45 as amended effective May 8, 1985 (Federal Register, Vol. 50, No. 45, 9368, 9369, 9379, March 7, 1985).♦

The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue: *Ex parte Scudder*, 169 USPQ 814. The Filing of a reissue application * * * ♦may not be♦ necessary if the only change is to correct the inventorship since this can be accomplished under the provisions of 35 U.S.C. 256 and 37 CFR 1.324.

A reissue was granted in *Brenner v. State of Israel*, 862 O.G. 661, 158 USPQ 584, where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 before the patent was granted.

Correction of failure to adequately claim priority in earlier filed copending U.S. Patent application was